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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/324,601	06/02/1999	STEVEN C. ROBERTSON		1766

7590 08/13/2004

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EXAMINER

FADOK, MARK A

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 08/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/324,601

Applicant(s)

ROBERTSON, STEVEN C.

Examiner

Mark Fadok

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/22/2004 and 5/22/2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Request for Continued Examination (RCE)

The examiner is in receipt of applicant's response to office action dated 10/15/2003, which was received 4/22 and 5/22/2004. Acknowledgment is made to the cancellation of claims 1-22, leaving claims 23-37 as pending in the application. The responses and second affidavit have carefully considered, but were not convincing, therefore the previous rejection is restated below modified as required by the submittal of the second affidavit:

Second Rule 1.131 affidavit

The response filed on 5/22/2004 under 37 CFR 1.131 has been considered but is ineffective to overcome the cited reference.

Reduction to Practice

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Webcertificate.com2 reference. Applicant claims on page two, paragraph 4 of the affidavit that the supplied pages 19-24 and 27 from notebook #1 dated 3-9-199 to 3-13-1999 constitute reduction to practice. "The same evidence sufficient for a constructive reduction to practice may be insufficient to establish an actual reduction to practice, which requires a showing of the invention in a physical or tangible form that shows every element of the count. Wetmore v. Quick, 536 F.2d 937, 942, 190 USPQ 223, 227 (CCPA 1976). For an actual reduction to practice, the invention must have been

sufficiently tested to demonstrate that it will work for its intended purpose, but it need not be in a commercially satisfactory stage of development” (See MPEP2138.05).

Further, in the interest of compact prosecution the applicant may argue that conception of the invention is evident in the supplied notebook pages, however, due diligence from prior to the reference date to the filing date of the application (constructive reduction to practice) is not clearly shown. “The period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses. *Rebstock v. Flouret*, 191 USPQ 342, 345 (Bd. Pat. Inter. 1975); *Rieser v. Williams*, 225 F.2d 419, 423, 118 USPQ 96, 100 (CCPA 1958) (Being last to reduce to practice, party cannot prevail unless he has shown that he was first to conceive and that he exercised reasonable diligence during the critical period from just prior to opponent's entry into the field); *Griffith v. Kanamaru*, 816 F.2d 624, 2 USPQ2d 1361 (Fed. Cir. 1987) (Court generally reviewed cases on excuses for inactivity including vacation extended by ill health and daily job demands, and held lack of university funding and personnel are not acceptable excuses.); *Litchfield v. Eigen*, 535 F.2d 72, 190 USPQ 113 (CCPA 1976).” Also, please note that Webcertificate.com¹ shows conception of the invention prior to 3/9/1999. Therefore, reduction to practice is considered to be the constructive date which is the filing date of the application 6/2/1999.

Failure to establish diligence

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the WebCretificate.com² reference to either a

constructive reduction to practice or an actual reduction to practice. In the present case, the applicant's have not properly established diligence through sketches, notebook entries, etc. for the entire time from prior to the date of the WebCretificate.com2 reference up to the date of reduction to practice (applicant's filing date). "An applicant must account for the entire period during which diligence is required." *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966). Statements that the subject matter "was diligently reduced to practice" is not a showing "but a mere pleading." *In re Harry*, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964). A 2-day period lacking activity has been held to be fatal. Diligence requires that Applicants must be specific as to dates and facts. *Kendall v. Searles*, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949). (Also see MPEP 2138.06). First, the applicant's stated date of working on the application is 1 day after the date of the WebCretificate.com2 reference (see attachment and para 7 to second affidavit). Further, a one-week break is unaccounted for between 5/22/1999 and 5/29/1999.

Lacks NAFTA/WTO allegation

The affidavit or declaration must contain an allegation that the acts relied upon to establish the date prior to the reference or activity were carried out in this country or in a NAFTA country or WTO member country. (See MPEP 715.07(c) and 35 U.S.C. 104).

Official Notice Statements

A "traverse" is a denial of an opposing party's allegations of fact. The Examiner respectfully submits that applicants' arguments and comments do not

appear to traverse what Examiner regards as knowledge that would have been generally available to one of ordinary skill in the art at the time the invention was made. Even if one were to interpret applicants' arguments and comments as constituting a traverse, applicants' arguments and comments do not appear to constitute an adequate traverse because applicant has not specifically pointed out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. 27 CFR 1.104(d)(2), MPEP 707.07(a). An adequate traverse must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying Examiner's notice of what is well known to one of ordinary skill in the art. In re Boon, 439 F.2d 724, 728, 169 USPQ 231, 234 (CCPA1971).

If applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. In re Chevenard, 139 F.2d 71, 60 USPQ 239 (CCPA 1943).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 23,24,25,26,28,29, rejected under 35 U.S.C. 103(a) as being unpatentable over WebCertificate.com (a collection of articles from the accompanying PTO 892 and listed as Webcertificate.com1 and 2) further in view of Official notice.

In regard to claim 23, webcertificate.com discloses a system for providing an electronic gift certificate service for users over a distributed network, comprising: a plurality of merchant sites connected to the distributed network (Webcertificate.com2, page 8), each merchant site running at least one application to provide an online service to users over the distributed network (Webcertificate.com2, page 12, line25-35); a plurality of user computers connected to the distributed network (Webcertificate.com1, page 1), each user computer running at least one application to access the online service at a merchant site (commonly used web browser which is used to contact the web address of webcertificate.com); a gift certificate authority site connected to the plurality of merchant sites(Webcertificate.com2, page 11, last 2 paragraphs), the gift certificate site including a user database and a merchant database, each database containing authentication information as to respective users and merchants Webcertificate.com teaches a database for managing a gift account including authentication information of registrants (Webcertificate.com page 12, para 6, and page 11 last paragraph), but does not specifically mention that the information is held in

multiple databases. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the information in any number of relational databases, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70,

, And a gift certificate database which stores gift certificate data and transaction data related to particular gift certificates (Webcertificate.com1 page 1, Cbase banking system and notification of expiration along with amount remaini9ng on certificate), the users accessing the merchant sites from the user computers over the distributed network (Webcertificate.com2, page 8); and an authentication protocol for allowing the gift certificate site to authenticate users and merchants As stated by the Applicant on page 16 of the specification "Upon the user choosing to use a gift certificate as payment, the Merchant Server Application 62 establishes a secure communication link with the Gift Certificate site 80. This involves the transmission of a "negotiate" message from the Merchant Server Application 62 to the Gift Certificate Registrar 82. This negotiate message includes the Merchant's unique ID, which may be in the form of a digital certificate. The Gift Certificate Registrar 82 on the Gift Registry Site 80 responds to the negotiate message by sending a pseudo-random "challenge" message to the Merchant's Gift Certificate Agent 64. In response to the challenge message, the Gift Certificate Agent 64 software generates and returns a cryptographic "response" message, which is based on both the challenge message and the SP's password. The above-described method of requesting authentication is commonly referred to as a "challenge-response authentication" protocol and is widely understood in the industry. It

is shown in FIG. 10 with the numbered arrows 1-4 indicating the order in which these messages are passed. For more detailed information, see Rivest, R., "The MD4 Message Digest Algorithm," Proceedings, Cryptop '90, Springer-Verlag, Aug. 1990. For a description of other cryptographic algorithms, which may be used, see Stallings, W., Network and Internetwork Security, Prentice Hall, 1995.)". As the Applicant has stated authentication protocol methods are old and well known in the art and could have been used by Webcertificates, because the central location would need to assure the identity of the;

whereby a user purchases a gift certificate having a unique gift certificate identification code on the gift certificate authority site for use at a merchant site Webcertificate.com2, page 3), and a merchant site processes the gift certificate through the gift certificate database on the gift certificate authority site (Webcertificate.com1, page 1).

In regard to claim 24, webcertificate.com teaches during user purchase of a gift certificate, the user placing restrictions on the use of the gift certificate Webcertificates.com teaches placing limits on the gift certificate such as amount of purchase and who may use the gift certificate.

In regard to claim 25, webcertificate.com teaches tracking use of the gift certificate by the user. Webcertificate.com2 provides a database for storing and tracking account balances (page 11, last paragraph), but does not specifically mention tracking the use of the gift certificates down to individual product or products purchased. As stated by applicant on page 11 para. 6 of the specification, "Sales Transaction information may contain but is not limited to the associated merchant that the purchase

was made from, product information including manufacturer ID, UPC Code, Merchant Code, Merchant Product Code, Product description, Quantity, Unit Prices, and Order totals including shipping and handling and taxes. All typical information that is associated with an online order is provided and stored with the transaction. This information is common knowledge in the industry". It would have been obvious to a person of ordinary skill in the art to include in Webcertificate.com the tracking capabilities that are old and well known in the art as stated by applicant, because this information can be used by the purchaser to supervise the activity of the gift recipient. This supervision capability would provide additional revenue from persons in need of this type of supervision.

In regard to claim 26, webcertificate.com teaches a search mechanism operatively associated with the gift certificate database that provides access to the user to those sales transactions associated with a particular user gift certificate (webcertificate.com2, page 11, last paragraph).

In regard to claim 28, webcertificate.com teaches within the gift certificate database, and in conjunction with merchant site processing of the gift certificate through the gift certificate database, splitting of the gift certificate across multiple purchases at a plurality of merchant sites (webcertificate.com2, page 2).

In regard to claim 29, webcertificate.com discloses a method for a user to purchase a gift certificate from an on-line gift certificate service, the method comprising

the steps of: user enters a desired dollar amount to be applied to the gift certificate; user enters a user-selected personal identification number (PIN) for authentication in a gift certificate redemption process; user provides payment information to the gift certificate site for purchasing the gift certificate; gift certificate site validates user payment information; and user receives an gift certificate order confirmation, including a unique gift certificate identification code (see discussion of claims 23-26,27 and 28 above and Webcertificate.com¹ and in their entirety).

In regard to claim 33, webcertificate.com teaches in the step of gift certificate order confirmation, the user selectively elects either immediate online display of the order confirmation, or later e-mail notification, or both (see response to claim 29 above).

In regard to claim 34, webcertificate.com discloses a method for redeeming a gift certificate from an on-line gift certificate service at a merchant site, the method comprising the steps of: user elects gift certificate as form of payment for selected goods or services at merchant site; user enters unique gift certificate identification code and user selected PIN; and merchant site communicates over distributed network with gift certificate authority site to authenticate the user gift certificate and complete user purchase of selected goods or services (see response to claim 29 above).

In regard to claim 35, webcertificate.com discloses a plurality of beneficiary sites connected to the distributed network, each beneficiary site running at least one application to provide an online service to users over the distributed network; a plurality of user computers connected to the distributed network, each user computer running at

least one application to access the online service at a beneficiary site; a contribution authority site connected to the plurality of beneficiary sites, the contribution site including a user database and a beneficiary database, each database containing authentication information as to respective users and beneficiaries, and a contribution database which stores contribution data and transaction data related to particular contributions, the users accessing the beneficiary sites from the user computers over the distributed network; and an authentication protocol for allowing the contribution site to authenticate users and beneficiaries; whereby a user makes a contribution having a unique contribution identification code on the contribution authority site for use at a beneficiary site, and a beneficiary site processes the contribution through the contribution database on the contribution authority site (see response to claims 23-34 above).

In regard to claim 36, webcertificate.com teaches, within the contribution database, and in conjunction with beneficiary site processing of the contribution through the contribution database, the contribution is set up to be selectively one-time or recurring automatic Webcertificate.com², page 10, paragraph 3.2 states "indicate when you would like the Webcertificate.com to be sent (immediately or at a later date), therefore, it is inherent in the system of Webcertificate.com that multiple orders can be made at varying times reoccurring on dates specified by the purchaser.

Claims 27 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Webcertificate.com, and further in view of Walker et al. (5,884,270).

In regards to claims 27 and 37 Webcertificates.com teaches providing a unique account number, but does not specifically mention maintaining the anonymity of the gift giver. Walker et al. teaches a communication system incorporating a central database of information supplied by one or more parties and managed by a central administrator, where all parties to the system can manage and control the release of any or all information about themselves or their identities, and where such a system allows for electronic-based communications between the parties without the necessity of revealing the identity of either party (col 4, lines 18-25) and specifically mentions the system can be use for making anonymous charitable gifts (col 1, line 64 to col 2, line 5). It would be obvious to a person of ordinary skill in the art to include in Webcertificate.com the teachings of anonymity provided by Walker, because providing this capability would allow a person that does not wish to have there identity known to use the system thus increasing revenue for the website.

Claims 30,31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Webcertificate.com, and further in view of Foladare (5,914,472).

In regards to claims 30,31 and 32, Webcertificates.com teaches placing limits on the gift certificate such as age of user and amount of purchase. Webcertificate.com also teaches a database for monitoring the transactions of the gift recipient, but does not specifically mention all the individual restrictions listed in claims 30,31 and 32. Foladare teaches a database of limits for monitoring and limiting a transaction card used by a minor (abstract and FIG 2). Foladare does not list all the specific limits cited in the

claims but does not limit the number or types of limitation that can be placed in the "limits" database (item 208), therefore, Foladare could include any number of restrictions including the ones listed in claims 30,31 and 32 if so desired. It would be obvious to a person of ordinary skill in the art to include these additional restrictions because additional restrictions would provide an automatic method of monitoring the use of a gift certificate.

Response to Arguments

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references (see combination of references Webcertificate.com 1 and 2). See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant's arguments filed 4/22 and 5/22 have been fully considered but they are not persuasive. Applicant argues that the applicant was in possession of the invention before the date of the Webcertificate.com2 reference. This assertion is provided in a second RULE 1.131 (b) affidavit dated May 14, 2004, however the affidavit was found to be defective as stated above. Therefore the rejection as stated stands.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **(703) 605-4252**. The examiner can normally be reached Monday thru Thursday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Vincent Millin** can be reached on **(703) 308-1065**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 308-1113**.

Any response to this action should be mailed to:

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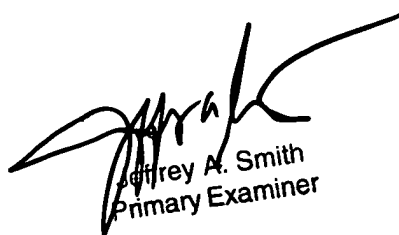
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Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal
Drive, Arlington, VA, 7th floor receptionist.



Mark Fadok

Patent Examiner



Jeffrey A. Smith
Primary Examiner